UNITED STATES PATENT AND TRADEMARK OFFICE

m N

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,701	09/22/2000	Yoshiki Kawaoka	5-009US-FF	9960

21254   7590   07/26/2007
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER
MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
2131	

MAIL DATE	DELIVERY MODE
07/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 May 2007</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,4-7,9-12,14 and 16-20</u> is/are pending in the application.

    4a) Of the above claim(s) <u>7,9 and 18</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,4-6,10-12,14,16,17,19 and 20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 September 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

    1.☒ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>see attachment</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1. This is in response to the communications filed on 7 May 2007.

2. Claims 1, 2, 4-7, 9-12, 14 and 16-20 are pending in the application.

3. Claims 1, 2, 4-6, 10-12, 14, 16, 17, 19 and 20 have been elected.

4. Claims 7, 9 and 18 are non-elected.

5. Claims 1, 2, 4-6, 10-12, 14, 16, 17, 19 and 20 have been rejected.

6. Claims 3, 8, 13 and 15 have been cancelled.

Information Disclosure Statement

7. The examiner has considered the information disclosure statement filed on 23 April 2007.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 10-12, 14, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated

by Kurachi U.S. Patent No. 6,181,436 B1.

As to claim 1, Kurachi discloses an image server for outputting encrypted image data to

at least one client terminal among a plurality thereof, comprising:

a selection unit for selecting, from among the plurality of client terminals,

a client terminal to which image data is to be output [column 14 line 61 to column

15 line 10];

an encryption unit for encrypting the image data using an encryption key

which corresponds to the client terminal that has been selected by the selection

unit [column 14 line 61 to column 15 line 10]; and

a transmitting unit for transmitting an image file storing image data that has

been encrypted by the encryption unit and data representing the client terminal

selected by the selection unit [column 14 line 61 to column 15 line 10].

As to claim 10, Kurachi discloses an image data output apparatus for outputting image data corresponding to a plurality of image printing units which print images represented by image data, comprising:

a designation unit for designating an output destination of applied image data from among the plurality of image printing units [column 12, lines 4-22];

a format conversion unit for converting a format of the applied image data so as to obtain a format conforming to the image printing unit that has been designated by the designation unit [column 12, lines 4-22];

a size adjustment unit for adjusting a size of the converted image data to obtain the image size printed by the image printing unit designed by the designation unit [column 12, lines 4-22]; and

an image data output unit for outputting the image data, the format whereof has been converted by the format conversion unit, to the image printing unit that has been designated by the designation unit [column 12, lines 4-22].

As to claim 11, Kurachi discloses an input unit for inputting an image file containing the image data and data indicating the output destination of this image data [column 12 line 66 to column 13 line 11], the designation unit designating the output destination of image data by data indicating the output destination that is contained in the image file that has been input by the input unit [column 12 line 66 to column 13 line 11].

As to claim 12, Kurachi discloses a printing management apparatus for managing printing conditions in a plurality of image printing units which print images represented by image data, wherein data representing printing history is output from the image printing units and the apparatus comprises:

a reading unit for reading data representing the printing history output from the image printing units [column 11, lines 5-45];

a format conversion unit for converting the data representing the printing history read by the reading unit to data having a predetermined format [column 11, lines 5-45]; and

an aggregating unit for aggregating, for each of the plurality of printing units, the data which represents printing history and the format of which has been converted by the format conversion unit [column 11, lines 5-45].

As to claim 14, Kurachi discloses a method of controlling an image server for outputting encrypted image data to at least one client terminal among a plurality thereof, the method comprising:

selecting, from among the plurality of client terminals, a client terminal to which image data is to be output [column 14 line 61 to column 15 line 10];

encrypting the image data using an encryption key which corresponds to the client terminal that has been selected [column 14 line 61 to column 15 line 10]; and

transmitting an image file storing image data that has been encrypted and

data representing the client terminal that has been selected [column 14 line 61 to

column 15 line 10].

As to claim 19, Kurachi discloses a method of outputting image data in an image data

output apparatus for outputting image data corresponding to a plurality of image printing units

which print images represented by image data, comprising:

designating an output destination of applied image data from among the

plurality of image printing units [column 12, lines 4-22];

converting a format of the applied image data so as to obtain a format

conforming to the image printing unit that has been designated [column 12, lines

4-22];

adjusting a size of the converted image data to obtain the image size

printed by the designated image printing unit [column 12, lines 4-22]; and

outputting the image data, the format whereof has been converted, to the

image printing unit that has been designated [column 12, lines 4-22].

As to claim 20, Kurachi discloses a printing management method for managing printing

conditions in a plurality of image printing units which print images represented by image data,

wherein data representing printing history is output from the image printing units and the method

comprises:

reading data representing the printing history output from the image

printing units [column 11, lines 5-45];

converting the data representing the printing history read to data having a

predetermined format [column 11, lines 5-45]; and

aggregating, for each of the plurality of printing units, the data which

represents printing history and the converted data [column 11, lines 5-45].

9. Claims 1, 10-12, 14, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated

by Thorne et al U.S. Patent No. 5,958,005.

As to claim 4, Thorne et al discloses an image printing system comprising:

an image selection unit for selecting at least one image from among a

plurality thereof [column 6 line 31 to column 7 line 21];

a print command unit for applying a command to print the image that has

been selected by the image selection unit [column 6 line 31 to column 7 line 21];

and

a printing unit, which is responsive to a print command applied by the

print command unit, for printing, on the same visible recording medium, the

image that has been selected by the image selection unit and information relating

to a copyright holder of the selected imag [column 6 line 31 to column 7 line 21]e.

As to claim 5, Thorne et al discloses an input unit for inputting data in which image data representing a plurality of images and information relating to copyrights of these images are associated with each other, the image selection unit selecting a desired image from among the plurality of images represented by the image data input by the input unit [column 10, lines 26-44].

As to claim 6, Thorne et al discloses an image printing system comprising:

a scanner for reading an image that has been recorded on a visible recording medium and outputting image data representing the read image [column 6 line 31 to column 7 line 21];

a determination unit for determining whether an image that has been read by the scanner contains visible information relating to a copyright holder of the image [column 6 line 31 to column 7 line 21];

an image printing unit for printing an image, which has been read by the scanner, in accordance with a determination by the determination unit that the read image does not contain information relating to the copyright holder [column 6 line 31 to column 7 line 21]; and

a printing controller for halting normal printing of the image by the image printing unit in accordance with a determination by the determination unit that the read image contains information relating to the copyright holder [column 6 line 31 to column 7 line 21].

As to claim 16, Thorne et al discloses an image printing method comprising:

selecting at least one image from among a plurality thereof [column 6 line 31 to column 7 line 21];

receiving a command to print the image that has been selected [column 6 line 31 to column 7 line 21]; and

printing, in response to a print command applied by the print command unit, on the same visible recording medium, the image that has been selected and information relating to a copyright holder of the selected image [column 6 line 31 to column 7 line 21].

As to claim 17, Thorne et al discloses an image printing method comprising:

reading an image that has been recorded on a visible recording medium and acquiring image data representing the read image [column 6 line 31 to column 7 line 21];

determining whether an image that has been read contains visible information relating to a copyright holder of the image [column 6 line 31 to column 7 line 21];

printing an image, which has been read, in accordance with a determination that the read image does not contain information relating to the copyright holder [column 6 line 31 to column 7 line 21]; and

halting normal printing of the image in accordance with a determination that the read image contains information relating to the copyright holder [column 6 line 31 to column 7 line 21].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi U.S. Patent No. 6,181,436 B1 as applied to claim 1 above, and further in view of Koyama et al U.S. Patent No. 6,011,897.

As to claim 2, Kurachi does not teach that the image data includes high-resolution image data for printing and display image data having a resolution lower than that of the high-resolution image data for printing, the encryption unit encrypting the high-resolution image data for printing.

Koyama et al teaches image data includes high-resolution image data for printing and display image data having a resolution lower than that of the high-resolution image data for printing [column 11, lines 30-46].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kurachi so that image data for printing would have been high-resolution. Images for display would have been a lower resolution than for printing. The higher-resolution images would have been encrypted for printing.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kurachi by the teaching of Koyama et al because by having a lower resolution recorded on a recording medium, it makes it possible to read out at a

high speed. The number of access operations with respect to the disc can be reduced [column 2, lines 58-63].

Conclusion

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy
July 22, 2007

CHRISTOPHER REVAK
PRIMARY EXAMINER